

### **REMARKS/ARGUMENTS**

The Office Action dated September 23, 2004 and the references cited therein have been carefully considered. In response to the Office Action, Applicants respectfully traverse the §102(e) rejections and have added new Claims 25-28 which, when considered with the remarks set forth below, is deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 1-23 and 25-28 remain in the case for continued prosecution.

In the Office Action, Claims 1, 2, 6-10 and 17 have been rejected under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent No. 6,444,397 to Hada et al and Claims 1 and 11-23 have been rejected under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent Application Publication No. 2003/0134232 to Yokoyama et al. However, the Examiner indicates that Claims 3-5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants thank the Examiner for his indication of allowable subject matter, but respectfully traverse the rejection of Claim 1 under 35 U.S.C. §102(e) on the grounds that the Hada et al patent does not disclose a composition as defined in Claim 1 and the Yokoyama et al publication is not prior art under §102(e). Accordingly, it is respectfully submitted that Claim 1, as filed, is allowable over both of these cited references.

Specifically, with respect to the Hada et al. patent, the Examiner states that Preparation 2, disclosed in column 8, lines 45-63 of the Hada et al. patent, shows a copolymer (hereinafter referred to as "copolymer C") of an  $\alpha$ -(hydroxymethyl) acrylic acid and ethyl  $\alpha$ -(hydroxymethyl) acrylate referred to as Polymer 2. The Examiner further states that the composition containing the copolymer C in Example 2 meets and anticipates the negative resist composition defined in Claim 1. However, the copolymer C disclosed in the Hada et al patent forms lactones by the crosslinking reaction between  $\alpha$ -(hydroxymethyl) acrylic acid and ethyl  $\alpha$ -(hydroxymethyl) acrylate or by the formation of a lactone ring between neighboring units and thereby is insolubilized in aqueous alkali solution. (See columns 5 and 6 of the Hada et al patent.)

In addition, both the  $\alpha$ -(hydroxymethyl) acrylic acid and ethyl  $\alpha$ -(hydroxymethyl) acrylate of Hada et al belong within (b1) of Claim 1 (i.e., “a unit which becomes insoluble in an alkali solution as a result of the formation of a lactone under the action of an acid generated from the component (A)”). There is absolutely no mention in the Hada et al patent of combining this component with (b2) of Claim 1 (i.e., “a unit having an alcoholic hydroxyl group”).

In stark contrast, Claim 1 defines an alkali-developable negative resist composition comprising a compound (A) which generates an acid upon exposure to radiation, and a resin component (B), which is made insoluble in alkali under the action of an acid. The component (B) is a resin component containing a unit (b1), which becomes insoluble in an alkali solution as a result of the formation of a lactone under the action of an acid generated from the component (A), and a unit (b2) having an alcoholic hydroxyl group. As is apparent from Claim 1, each of the lactones is formed in the unit (b1), which thereby insolubilizes the resin component (B), and the resin component (B) does not essentially form a lactone between units (b1) and (b2). Therefore, the composition defined in Claim 1 of the present invention is clearly different from the composition disclosed in the Hada et al patent and, accordingly, Claim 1 is patentable over the Hada et al patent.

With respect to the Yokoyama et al publication, it is respectfully submitted that this reference is not prior art under 35 U.S.C. §102(e). In particular, in order to be prior art under §102(e), a published application must be “filed in the United States before the invention by the applicant.” It is first noted that the effective filing date of the Yokoyama et al publication is the filing date of the corresponding U.S. application, or November 15, 2002. (See MPEP §706.02(V) and §706.02(f)(1)(I)(D).) In the present application, Applicants claim priority to JP 2002-152699, filed in Japan on May 27, 2002. Applicants respectfully submit that this priority document establishes a date of invention earlier than the effective filing date of the Yokoyama et al publication and, therefore the Yokoyama et al publication is not prior art under 35 U.S.C. §102(e).

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Amendment dated December 16, 2004  
Reply to Office Action of September 23, 2004

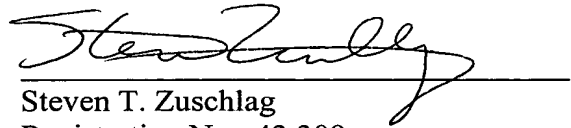
MPEP §706.02(b) states that a rejection based on 35 U.S.C. § 102(e) can be overcome by perfecting a claim of priority under 35 U.S.C. §119(a)-(d) to a foreign application having a filing date that antedates the cited reference and satisfies the enablement and description requirements of 35 U.S.C. § 112, first paragraph. Applicants respectfully submit that the claim of priority to JP 2002-152699, filed on May 27, 2002, was perfected in Applicants' Combined Oath and Declaration filed together with the present application and the Examiner has already acknowledged receipt of the certified copies of the priority documents. (For the convenience of the Examiner, Applicants have enclosed herewith additional certified copies of the priority documents.) Finally, in order to establish the enablement and description requirements of 35 U.S.C. § 112, first paragraph, Applicants further submit herewith an English translation of priority application JP 2002-152699, which supports Claim 1 of the present invention. Accordingly, Applicants respectfully submit that their claim of priority to JP 2002-152699, filed on May 27, 2002, has been perfected and that this application establishes an earlier date of invention than the Yokoyama et al publication. Therefore, it is respectfully submitted that the rejection based on 35 U.S.C. §102(e) with respect to the Yokoyama et al publication has been overcome, and it is requested that this rejection be withdrawn.

Accordingly, for all the foregoing reasons, it is respectfully submitted that independent Claim 1, and the Claims that depend therefrom, patentably distinguish over the Hada et al patent and the Yokoyama et al publication. Moreover, since it is believed that Claim 1 is in condition for allowance, it is respectfully requested that previously withdrawn Claim 24 be reinstated.

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In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 1-28 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven T. Zuschlag", is written over a horizontal line.

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